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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,761	02/09/2004	Kevin J. Mills	SC.2002.9	6169
23339	7590	10/21/2005		
WALSTEIN BENNETT SMITH III P. O. BOX 1668 GEORGETOWN, TX 78628			EXAMINER AUVE, GLENN ALLEN	
			ART UNIT	PAPER NUMBER
			2111	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/774,761

Applicant(s)

MILLS ET AL.

Examiner

Glenn A. Auve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9 and 12-20 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/2/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is rejected based on lack of positive antecedent basis of "the third coupling" on lines 1-2.

Claim 9 is also rejected based on lack of positive antecedent basis of "the third coupling" on lines 1-2.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 2-7 and 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Harari et al., U.S. Pat. No. 5,887,145 (cited by applicant).

As per claim 2, Harari shows an expansion module (removable mother card 10) for use in conjunction with a removable expansion card (daughter card module 20), an I/O device (fig.8B module 20 and col.10, lines 40-60 which explain that one of the cards can be a memory

card and the other can be a peripheral or I/O device), and a computing host (200) having an externally accessible first expansion coupling (212), the expansion module comprising: an assembly adapted to directly removably attach with the computing host via the first expansion coupling (10), the assembly including a second expansion coupling (14), adapter circuitry to manage data transfers with the removable expansion card (40), and an I/O interface adapted to couple with the I/O device (fig. 8B as noted above); wherein independent of the attachment of the assembly to the computing host, the second expansion coupling is externally accessible and is adapted to directly removably attach with the removable expansion card, the removable expansion card nesting within the assembly when attached thereto (throughout the figures); and wherein the first externally accessible coupling and the second externally accessible coupling are respectively a first-level coupling and a second-level coupling, the expansion module is a first-level module adapted to couple to the computing host via the first-level coupling, the removable expansion card is a second-level module adapted to couple to the first-level module via the second-level coupling, and the data transfers include transferring information between the first-level module and the second-level module (also throughout the drawings and the specification wherein the daughter card couples to the host system via connection to the mother card). Harari shows all of the elements recited in claim 2.

As for claim 3, the argument for claim 2 applies. Harari also shows that the computing host is a portable host (col.4, lines 34-45). Harari shows all of the elements recited in claim 3.

As for claim 4, the argument for claim 2 applies. Harari also shows that the computing host is a PDA (col.4, lines 34-45). Harari shows all of the elements recited in claim 3.

As for claim 5, the argument for claim 2 applies. Harari also shows that the removable expansion card is a removable memory (throughout the specification, see at least cols. 4 and 10 as noted above). Harari shows all of the elements recited in claim 5.

As for claim 6, the argument for claim 2 applies. Harari also shows that the removable expansion card is a first removable expansion card (20) and the assembly is a second removable expansion card (10). Harari shows all of the elements recited in claim 6.

As for claim 7, the argument for claim 2 applies. Harari also shows that the second removable expansion card nests within the computing host when attached thereto (fig.1). Harari shows all of the elements recited in claim 7.

As for claim 12, the argument for claim 2 applies. Harari also shows that the first coupling includes a first slot; and the second coupling includes a second slot (fig.1). Harari shows all of the elements recited in claim 12.

As for claim 13, the argument for claim 2 applies. Harari also shows that the I/O interface is adapted to couple to an antenna external to the assembly (col.5, line 1, wherein the wireless fax modem inherently requires an antenna). Harari shows all of the elements recited in claim 13.

As for claim 14, the argument for claim 2 applies. Harari also shows that the I/O interface is adapted to couple to a communications link external to the assembly (col.10, lines 56-60). Harari shows all of the elements recited in claim 14.

As for claim 15, the argument for claim 2 applies. Harari also shows that the I/O interface is adapted to couple to a communications subsystem external to the assembly (col.10, lines 56-60). Harari shows all of the elements recited in claim 15.

As for claim 16, the argument for claim 2 applies. Harari also shows that the I/O interface is coupled to a receiver (col.10, lines 56-60, where the fax/modem acts as a receiver). Harari shows all of the elements recited in claim 16.

As for claim 17, the argument for claim 2 applies. Harari also shows that the I/O interface includes a telephone interface (col.10, lines 56-60). Harari shows all of the elements recited in claim 17.

As for claim 18, the argument for claim 2 applies. Harari also shows that the I/O interface includes an antenna interface (col.5, line 1, wherein the wireless fax modem inherently requires an antenna). Harari shows all of the elements recited in claim 18.

As for claim 19, the argument for claim 2 applies. Harari also shows that the I/O interface includes a network interface (col.4, line 65 – col. 5, line 1). Harari shows all of the elements recited in claim 19.

As for claim 20, the argument for claim 2 applies. Harari also shows that the I/O interface includes a serial interface (col.7, lines 34-36). Harari shows all of the elements recited in claim 20.

#### ***Allowable Subject Matter***

5. Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference to Gochi shows a PCMCIA card that includes memory and I/O interface and appears to meet the limitations of claim 2. Bricaud et al. shows a PCMCIA card that includes a slot and connector for a memory module as well as an I/O connector for a telecommunications line that also appears to at least meet the limitations of claim 2.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (571) 272-3623. The examiner can normally be reached on M-F 8:00 AM-5:30 PM, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (571) 272-3632. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn A. Auve  
Primary Examiner  
Art Unit 2111

gaa  
14 October 2005